

REMARKS

The above-referenced patent application has been reviewed in light of the Office Action referenced above. Reconsideration of the above-referenced patent application in view of the following remarks is respectfully requested.

Claims 1-22 are pending in the application. Claims 1-22 have been amended. New claims 23-30 have been added. The amendment is fully supported by the original disclosure. No new matter has been introduced. The above amendment were, in many instances, made to clarify Assignee's claims and do not narrow the scope of the amended claims. Furthermore, in many instances, the above amendments broaden the literal scope of claims and/or claim elements. In light of this, Assignee asserts that no prosecution history estoppel should result from the above amendments.

Claim Rejections:

The Examiner has rejected claims 1 and 15 under 35 USC §103 as being unpatentable over US Patent No. 6,657,749 (hereinafter "Beeson") in view of US Pub. App. No. US2002/0140996 (hereinafter "Spears"). This rejection is respectfully traversed.

In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. MPEP 2142. To establish a prima facie case of obviousness, three basic criteria must be met: first, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; second, there must be a reasonable expectation of

success; finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP 2142.

Independent claim 1 recites "*an image processor, capable of calculating an optical path deviation based at least in part on the calibrated images to adjust the scanned image*". The Examiner asserts that Beeson discloses a "set of calibration photosensitive devices, (CCDs 318, 314 of fig 1) located at two sides of the set of scan photosensitive devices (117 of fig 3) to obtain a set of calibrated images; and an image processor, (124 of fig 3) to extract and compare the calibrated images for adjusting the scanned image, col. 6, lines 48-55)". See page 3 of the Office Action. Additionally, the Examiner asserts that the combination of the "set of calibration boards (204 and 206 of fig 2 and 3)" of Spears with the device of Beeson would have been obvious "for the reason that, the second calibration strip is used to compensate for variation in lamp intensity during a scan." See page 3 of the Office Action. However, the Examiner has provided no support for the proposition that, in the proposed combination, the controller 124 of Beeson would operate with the calibration strips 204 and 206 of Spears to be "*capable of calculating an optical path deviation based at least in part on the calibrated images to adjust the scanned image*" as is claimed. Indeed, the Examiner has instead suggested that the use of the calibration strips 204 and 206 of Spears would operate to "compensate for variation in lamp intensity during a scan." See page 3 of the Office Action. In the absence of the Examiner pointing to such a disclosure in the proposed combination, Assignee requests that the rejection be withdrawn as the Examiner has failed to establish that the proposed combination renders obvious all of the features of claim 1.

Claims 2-30 are similarly not obvious, at least on the same or similar basis as claim 1.

It is noted that claimed subject matter may be patentably distinguished from the cited patent for additional reasons; however, the foregoing is believed to be sufficient. Likewise, it is noted that the Assignee's failure to comment directly upon any of the positions asserted by the Examiner in the office action does not indicate agreement or acquiescence with those asserted positions.

CONCLUSION

In light of the foregoing, reconsideration and allowance of the claims is hereby earnestly requested.

If the Examiner has any questions, he is invited to contact the undersigned at (503) 439-6500.

ADDITIONAL FEES

Any fees or extensions of time believed to be due in connection with this amendment are enclosed herein; however, consider this a request for any extension inadvertently omitted, and charge any additional fees to Deposit Account 50-3703.

Respectfully submitted,
ATTORNEY FOR ASSIGNEE

Dated: February 10, 2006

/James J. Lynch Reg. No. 50,153/

James J. Lynch
Reg. No. 50,153

Customer No. 43831

Berkeley Law and Technology Group, LLC
1700 NW 167th Place, Suite 240
Beaverton, OR 97006
503.439.6500